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REMARKS

Claims 1-32 are pending in the present application. In the Office Action of March 10, 2005, all claims were rejected. Applicants hereby traverse the rejections as follows.

Rejection under 35 U.S.C. 102(b)

Claims 1, 7-13, 20-22 and 29-31 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sellers et al. (US 5,311,438). Applicants respectfully traverse this rejection.

Claim 1

Claim 1 is directed to a method for measuring a benefit of a business improvement. The method includes steps of receiving actual performance information, storing the actual performance information in a storage device, retrieving the actual performance information, and calculating the benefit of implementing the business improvement by comparing the actual performance information to estimated performance information.

Sellers et al. does not teach or suggest all of the elements recited in Applicants' claim 1. Sellers et al. at least does not teach or suggest calculating the benefit of implementing the business improvement by comparing the actual performance information to estimated performance information, as recited in claim 1.

Sellers et al. is directed to an integrated manufacturing system that utilizes a common database structure and product definition to integrate multiple systems. A new product development system can be integrated with the common database to facilitate the process of developing new products. The manufacturing system can calculate projected component usage quantities based on a recorded production quantity for a product and can deduct the calculated usage quantity from inventory for each component. Before the calculated usage quantities are deducted from inventory balances, the ability exists to override the calculated quantities with actual usage quantities. The manufacturing system also can track production statistics for a product including the variance between planned and actual yield loss for a production process. The manufacturing system also includes a new product development feature that appears to include a function for performing a financial simulation for a new product design.

In rejecting claim 1, the Examiner appears to read "implementing a business improvement" to include "developing a new product." Applicants' invention, however, is

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directed to calculating the benefit of implementing an improvement in a service business, not to calculating the cost of manufacturing a new product and tracking component inventories for manufacturing that product. Sellers et al. does not disclose a method or system that calculates the benefit of such a service business process improvement, but instead only describes a system for calculating the cost of manufacturing a new product and tracking component inventories for manufacturing that product. Applicants respectfully submit, therefore, that Sellers et al. does not anticipate claim 1.

Claims 7-12

Each of claims 7-12 depends from and includes all of the limitations of claim 1. For the reasons discussed above, therefore, Applicants also submit that Sellers et al. does not anticipate claims 7-12. In addition Sellers et al. does not anticipate claims 7-12 for the following reasons.

Claim 7 is directed to the method of claim 1 wherein the operation of calculating the benefit of implementing the business improvement comprises calculating an actual cost savings. In rejecting claim 7, the Examiner cites column 115, lines of 63-64 of Sellers et al. The cited portion of Sellers et al., however, specifically refers to the use of estimated costs, not actual costs.

Claim 8 is directed to the method of claim 1 wherein the operation of calculating the benefit of implementing the business improvement comprises calculating an actual revenue increase. In rejecting claim 8, the Examiner cites column 115, lines of 63-64 of Sellers et al. The cited portion of Sellers et al., however, specifically refers to the use of estimated information, not actual information.

Claim 9 is directed to the method of claim 1 wherein the actual performance information comprises a time associated with a predefined event. In rejecting claim 9, the Examiner appears to cite column 113, lines 44-59 of Sellers et al. The cited portion of Sellers et al. specifically references a present value payback period. Again, however, it only mentions this in the context of a financial simulation using estimated information, not actual performance information.

Claim 10 is directed to the method of claim 2 wherein calculating the actual return-on-investment includes operations of determining a first profitability figure over a selected time period using the actual performance information, determining a second profitability figure over a length of time equal to the selected time period using the estimated performance information,

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determining a profitability difference between the first profitability figure and the second profitability figure, and subtracting a cost of the improvement from the profitability difference.

In rejecting claim 10, the Examiner cites column 113, lines 44-58, column 78, line 54, and column 114, line 13 of Sellers et al. The cited portions of Sellers et al. refer to design project milestones, estimated product development time and target completion dates, as well as production statistics and design request financial analysis. To the extent there is any reference to profitability, it arguably is in connection with the design request financial analysis reference (column 114, line 13).

Claim 10 depends from and includes all of the features of claim 2. In the Office Action, however, the Examiner acknowledges that Sellers et al. fails to teach all of the features of claim 2. Specifically, the Examiner acknowledges that Sellers et al. fails to teach actual return on investment (Office Action at page 7-8). Therefore, the Examiner acknowledges that claim 2 is not anticipated by Sellers et al. Because claim 10 also includes all of the features of claim 2, claim 10 likewise cannot be anticipated by Sellers, et al.

Each of claims 11 and 12 depends from and includes all of the limitations of claim 10. For the reasons discussed above with respect to claim 10, therefore, Applicants also submit that Sellers et al. does not anticipate claims 11 and 12.

Claims 13, 20 and 21

Claim 13 is directed to an apparatus measuring a benefit of a business improvement. The apparatus includes an interface for receiving actual performance information, a storage device for storing the actual performance information and for storing estimated performance information, and a processor for retrieving the actual performance information and the estimated performance information and for calculating the benefit using at least the actual performance information and the estimated performance information.

Sellers et al. does not teach or suggest all of the elements recited in Applicants' claim 13. As discussed above, Sellers et al. at least does not teach or suggest a processor for calculating the benefit using at least the actual performance information and the estimated performance information.

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Claim 20 includes all of the limitations of claim 13. For the reasons discussed above, therefore, Applicants also submit that Sellers et al. does not anticipate claim 20. In addition Sellers et al. does not anticipate claim 20 for at least the following reasons.

Claim 20 is directed to the apparatus of claim 13 wherein the benefit comprises an actual return-on-investment of the improvement and wherein calculating the actual return-on-investment includes operations of: determining first profitability figure over a selected time period using the actual performance information; determining a second profitability figure over a length of time equal to the selected time period using the estimated performance information; determining a profitability difference between the first profitability figure and the second profitability figure; and subtracting a cost of the improvement from the profitability difference. In rejecting claim 20, the Examiner cites his reasons for rejecting claim 1. For the reasons set forth above with respect to claim 1, Applicants therefore respectfully submit that Sellers et al. also does not teach or suggest all of the elements recited in Applicants' claim 20. In addition, the Examiner has not cited to any portion of Sellers et al. that discloses the steps expressly recited in claim 20 that are not included in claim 1.

Claim 21 includes all of the limitations of claim 13. For the reasons discussed above, therefore, Applicants also submit that Sellers et al. does not anticipate claim 21. In addition Sellers et al. does not anticipate claim 21 for at least the following reasons.

Claim 21 recites the apparatus of claim 13 wherein the benefit includes an actual return-on-investment of the improvement and wherein calculating the actual return-on-investment includes: determining a performance difference between actual performance information taken over a predetermined time period and estimated performance information estimated over a length of time equal to the predetermined time period; calculating a profitability difference over the selected time period using the performance difference; and subtracting a cost of the improvement from the profitability difference.

In rejecting claim 21, the Examiner cites column 98, lines 24-60, and column 113, lines 44-59 of Sellers et al. The cited portions of Sellers et al. refer to design project milestones, estimated product development time and target completion and to the use of estimated costs. They do not address calculating an actual return on investment or using actual performance information. More specifically, they do not disclose calculating an actual return on investment

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that includes determining a performance difference between actual performance information taken over a predetermined time period and estimated performance information estimated over a length of time equal to the predetermined time period, calculating a profitability difference over the selected time period using the performance difference, and subtracting a cost of the improvement from the profitability difference, as recited in claim 21.

Claims 22, 29 and 30

Claim 22 is directed to a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform a method for measuring a benefit of a business improvement. The method includes operations of: receiving actual performance information; storing the actual performance information in a storage device; retrieving the actual performance information; and calculating the benefit using at least the actual performance information and estimated performance information. In rejecting claim 22, the Examiner cites his reasons for rejecting claim 1. For the reasons set forth above with respect to claim 1, Applicants therefore respectfully submit that Sellers et al. also does not teach or suggest all of the elements recited in Applicants' claim 22.

Each of claims 29-30 depends from and includes all of the limitations of claim 22. For the reasons discussed above with respect to claim 22, therefore, Applicants also submit that Sellers et al. does not anticipate claims 29-30. In addition, Sellers et al. does not anticipate claims 29-30 for at least the following reasons.

Claim 29 is directed to the signal-bearing medium of claim 24 wherein calculating the actual return-on-investment includes operations of: determining a first profitability figure over a selected time period using the actual performance information; determining a second profitability figure over a length of time equal to the selected time period using the estimated performance information; determining a profitability difference between the first profitability figure and the second profitability figure; and subtracting a cost of the improvement from the profitability difference. In rejecting claim 29, the Examiner cites his reasons for rejecting claim 10. For the reasons set forth above with respect to claim 10, Applicants therefore respectfully submit that Sellers et al. also does not teach or suggest all of the elements recited in Applicants' claim 29.

Claim 30 is directed to the signal-bearing medium of claim 24 wherein calculating the actual return-on-investment includes operations of: determining a performance difference

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between actual performance information taken over a predetermined time period and estimated performance information estimated over a length of time equal to the predetermined time period; calculating a profitability difference over the selected time period using the performance difference; and subtracting a cost of the improvement from the profitability difference. In rejecting claim 30, the Examiner cites his reasons for rejecting claim 1. For reasons set forth above with respect to claim 1, Applicants therefore respectfully submit that Sellers et al. also does not teach or suggest all of the elements recited in Applicants' claim 30. In addition, the Examiner has not cited to any portion of Sellers et al. that discloses the steps expressly recited in claim 30 that are not included in claim 1.

Claim 31

Claim 31 is directed to a method for measuring a benefit of a business improvement. The method includes operations of: storing a first set of actual performance information prior to implementation of the business improvement; storing a second set of actual performance information after implementation of the business improvement; retrieving the first set and the second set of actual performance information; and calculating the benefit of implementing the business improvement by comparing the first set and the second set of actual performance information. In rejecting claim 31, the Examiner cites his reasons for rejecting claim 1 and further asserts that "mere multiplicity is not novelty."

For at least the reasons set forth above with respect to claim 1 and the following reasons, Applicants respectfully submit that Sellers et al. also does not teach or suggest all of the elements recited in Applicants' claim 31. The Examiner has not cited to any portion of Sellers et al. that discloses calculating the benefit of implementing the business improvement by comparing the first set and the second set of actual performance information of actual performance information. Moreover, the Examiner has not specifically pointed out the basis for his conclusion that "mere multiplicity is not novelty." Applicant, therefore, respectfully requests the Examiner to do so if the Examiner maintains this rejection.

Rejection under 35 U.S.C. 103(a)

Claims 2-6, 14-19, 23-28 and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sellers et al. (US 5,311,158) in view of the Dictionary of Business Terms. Applicant respectfully traverses these rejections.

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Applicants respectfully submit that Sellers et al. and the Dictionary of Business Terms do not render Applicants' any of rejected claims obvious for at least two reasons. First, obviousness cannot be established unless there is some suggestion or motivation to modify the reference to produce the claimed invention. MPEP § 2142. The mere fact that the Dictionary of Business Terms includes certain business terms does not in any way suggest modifying the system of Sellers et al. to achieve Applicants' invention. Thus, in concluding that the combination of Sellers et al. and the Dictionary of Business Terms renders claims 2-6, 14-19, 23-28 and 32 obvious, the Examiner appears to have relied on Applicants' disclosure to find the motivation to achieve Applicants' claimed invention. It is impermissible, however, to resort to hindsight based on the Applicants' disclosure to reach a conclusion that such a suggestion or motivation exists. See MPEP § 2142.

Second, a finding of obviousness requires that all claim limitations of the Applicant's invention must be taught or suggested by the prior art. MPEP § 2143.03. The combination of Sellers et al. and the Dictionary of Business Terms, however, does not teach or suggest all of the elements of Applicants' claims 2-6, 14-19, 23-28 and 32. Each of these claims depends from one of claims 1, 13, 22 and 31. For at least the reasons discussed above with respect to the Examiner's rejection under 35 U.S.C. § 102(b), however, the combination of Sellers et al. and the Dictionary of Business Terms also does not teach or suggest all of the elements recited in Applicants' claims 1, 13, 22 and 31.

Claims 2-6 depend from and include all of the limitations of claim 1 and further recite additional features. Claim 2 recites that the operation of calculating the benefit of implementing the business improvement comprises calculating an actual return-on-investment of the business improvement. Claim 3 recites that the operation of calculating the benefit of implementing the business improvement comprises calculating an actual total cost of ownership. Claim 4 recites the operation of calculating the benefit of implementing the business improvement comprises calculating an actual net present value. Claim 5 recites that the operation of calculating the benefit of implementing the business improvement comprises calculating an actual internal rate of return. Claim 6 recites that the operation of calculating the benefit of implementing the business improvement comprises calculating an actual payback period.

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In rejecting claims 2-6, the Examiner cites column 113, lines 44-49 of Sellers et al. As previously discussed, this cited portion of Sellers et al. specifically refers to the use of estimated information, not actual information.

Claims 14-19 depend from and include all of the limitations of claim 13 and further recite additional features. Claim 14 recites that the benefit comprises an actual return-on-investment of the improvement. Claim 15 recites that the actual performance information comprises a time associated with a predefined event. Claim 16 recites that the benefit comprises an actual total cost of ownership of the improvement. Claim 17 recites that the benefit comprises an actual net present value of the improvement. Claim 18 recites that the benefit comprises an actual internal rate of return of the improvement. Claim 19 recites that the benefit comprises an actual payback period of the improvement.

In rejecting claims 14-19, the Examiner cites his reasons for rejecting claims 2, 9, 3, 4, 5 and 6, respectively. For at least the reasons set forth above with respect to claims 13, 2, 9, 3, 4, 5, and 6, therefore, Applicants respectfully submit that claims 14-19 are not rendered obvious.

Claims 23-28 depend from and include all of the limitations of claim 22 and further recite additional features. Claim 23 recites that the actual performance information comprises a time associated with a predefined event. Claim 24 recites that operation of calculating the benefit comprises the operation of calculating an actual return-on-investment. Claim 25 recites that the operation of calculating the benefit comprises the operation of calculating an actual total cost of ownership. Claim 26 recites that the operation of calculating the benefit comprises the operation of calculating an actual net present value. Claim 27 recites that the operation of calculating the benefit comprises the operation of calculating an actual internal rate of return. Claim 28 recites that the operation of calculating the benefit comprises the operation of calculating an actual payback period.

In rejecting claims 23-28, the Examiner cites his reasons for rejecting claims 15, 2, 3, 4, 5, and 6, respectively. For at least the reasons set forth above with respect to claims 22, 15, 2, 3, 4, 5, and 6, therefore, Applicants respectfully submit that claims 23-28 are not rendered obvious.

Claims 32 depends from and includes all of the limitations of claim 31 and further recites that the benefit is selected from the group consisting of an actual return-on-investment, an actual total cost of ownership, an actual net present value, an actual internal rate of return, and an actual

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payback period. In rejecting claim 32, the Examiner cites his reasons for rejecting claims 3, 4 and 5. For at least the reasons set forth above with respect to claims 31, 3, 4 and 5, therefore, Applicants also respectfully submit that claim 32 is not rendered obvious.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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